

REMARKS

The above Amendment and following Remarks are responsive to the points raised in the May 14, 2003 Office Action. In the Office Action, claims 1-15 and 33-37 were rejected under 35 U.S.C. § 103(a) and claims 16-32 and 38-41 were required to be canceled by the Examiner as drawn to a non-elected invention. Upon entry of this Amendment, claims 16-32 and 38-41 will have been canceled and claims 1-15 and 33-37 will be pending in this application. Applicant reserves the right to pursue claims directed to the canceled claims in any continuing applications filed hereafter. No new matter has been added by this Amendment. Entry and consideration of this Amendment are respectfully requested.

Telephone Discussion:

The Applicant would like to thank the Examiner for the time spent discussing this application by telephone on June 25, 2003. In response to that discussion, Applicant has filed remarks as suggested by the Examiner describing the impossibility of combining the references applied to the claims. Claims 1-15 and 33-37 are believed to be allowable and an early notice to such effect is earnestly solicited. Should the Examiner have any questions or comments regarding this Amendment and Response, he is urged to telephone the undersigned attorney.

Rejections Under 35 U.S.C. § 103(a):

Claims 1-5, 7, 11, and 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell (U.S. Patent No. 1,600,396) in view of Seufert (U.S. Patent No. 4,733,916). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell and Seufert and further in view of Seufert (U.S. Patent No. 4,064,206). Claims 8-10 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Campbell and Seufert and further in view of Haddock (U.S. Patent No. 3,735,674). Applicant traverses these rejections.

Campbell teaches a method of reinforcing fiberboard that specifically requires applying a reinforcing tape to the carton blank before scoring. The scoring is then performed while the tape is not dry so that the tape is free to slip when the scoring is performed to prevent distortion and cracking of the adhesive bonding. In contrast, Seufert teaches the formation of a thinned down area in a plastic foil blank and the precise aligning of the thinned down area over groove lines already scored in the cardboard blanks. The Examiner avers that the plastic foil of Seufert is a reinforcement material with one section wider than an other section as claimed. The Examiner then avers that the presently claimed invention would have been obvious to one of ordinary skill in the art in view of the combination of the Campbell and Seufert references. However, according to MPEP 2143.02, a proposed modification to a reference cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. As applied herein, Applicant avers that the proposed combination would be contrary to the teachings of Campbell and Seufert and the claimed methods are thus not obvious in view of a combination of these references.

Specifically, Applicant avers that such a combination of Campbell and Seufert is not possible and, even if such a combination were somehow made, that such a combination would not result in the claimed method. If the methods of Campbell and Seufert were somehow combined, the combination would result in either a plastic film that is applied as reinforcement before scoring that will lose its stress equalization properties or would result in a plastic film that is applied to an unscored fiberboard when not dry. Neither of these combinations is permissible in view of the Campbell or Seufert references and neither of these combinations satisfies the claimed method. The Campbell reference specifies in column 2, lines 81-86 that:

It is the essential feature of our invention that tapes are so placed into a carton or container blank as to re-enforce the score lines, and the scoring is done while the bond between the tapes and the paper is not dry, but is free to slip when scoring is done.

Thus, Campbell requires the reinforcement material be applied before scoring is performed. A combination of the Campbell and Seufert references to attempt to reach the claimed method would require the use of the foil material of Seufert as the reinforcing material as relied upon in the Office Action. The foil material of Seufert is a thinned down section of foil that would have to be applied in place of the tape of Campbell before scoring was performed. However, this combination of Seufert's foil in Campbell's method would result in a thinned down foil that has been scored, which would weaken the foil and cause it to lose its purpose of uniform stress equalization. Thus, since substituting the foil of Seufert in place of the tape of Campbell would be contrary to the stated purpose of Seufert, such a combination would be improper and, even if made, would not result in the claimed method.

As another option, the combination of Campbell and Seufert could result in the "not dry" tape of Campbell applied to a prescored fiberboard as in Seufert. If the method of Seufert were applied to the blank of Campbell, the combination would require the tape of Campbell to be used in place of the plastic film and placed on a prescored fiberboard. This combination would result in a scored fiberboard overlaid with a tape that has not been scored, which is clearly contrary to both the Seufert and Campbell references and does not result in the claimed method.

Thus, Applicant avers that the combination of Campbell and Seufert references is not possible and, even if such a combination were somehow made, that such a combination would not result in the claimed method.

The Examiner has not established a prima facie case of obviousness

Claims 1-5, 7, 11 and 33-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Campbell et al.* in view of *Seufert*, which rejection has been made final. As noted in Applicant's prior response and as acknowledged by the Examiner in the Official Action, to establish a *prima facie* case of obviousness for combining or modifying the teachings of prior art to try to produce the claimed invention, there must be a showing that there is some teaching, suggestion or motivation to make such combination found either in the references themselves or in the knowledge generally available to one of skill in the art. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the present case, no such suggestion to combine the folding box of *Seufert* with the method of reinforcing fiberboard taught by *Campbell et al.* has been offered or shown in the rejection of the currently pending claims, and even if the references were combined, such combination would not be successful for forming the claimed invention.

In order to make a case of obviousness, "a prior art reference must be considered in its entirety, *i.e.* as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Thus, in trying to combine *Campbell et al.* and *Seufert*, both references must be considered in their entireties for everything that they teach, including specific disclosures that advocate or teach away from the claimed invention and each other, and it is not permissible to pick and choose isolated teachings or disclosures in such references in order to try to make a claim of obviousness under § 103. See MPEP § 2142.02; *In Re Antonine*, 559 F.2d 618, 195 USPQ 6 (CPA 1977). In the present case, the cited references teach and disclose very different types of products, *i.e.* *Campbell et al.* teaches a box with a series of tapes applied along sections of fold lines, while *Seufert* discloses a folding display box with a thin, transparent

thermoplastic material attached to cardboard, but which does not act as a reinforcing member, nor is any reinforcement apparently provided by this thin plastic material in *Seufert*. In addition, the references appear to sufficiently teach away from each other in the manner of formation of the boxes shown therein.

Campbell et al. illustrates and discloses a process for reinforcing fiberboard for use in making shipping cases, cartons, and packing sheets, a specific requirement is that after the reinforcing tapes are applied to the carton blank, scoring is done while the bond between the tapes and the taper of the carton or container blank is not dry so that the tapes are free to slip when scoring is done and is to prevent distortion and cracking of the adhesive bonding the tapes to the paper of the carton during scoring. By contrast, *Seufert* teaches the formation of thinned down areas in the plastic foil blank 3 to compensate for stresses in the foil material, which can be formed with the formation of the bend lines 13 in the plastic foil material, but also are stated to be formed in the foil 13 prior to its application to the cardboard blank. (See Col. 2, l. 57 – 63). *Seufert* further requires that the bend lines or fold lines 13 formed in the foil material must be precisely aligned with groove lines already scored in the cardboard blanks. Consequently, there is no need for subsequent scoring of the transparent plastic foil material and cardboard of *Seufert* as required by the method of *Campbell et al.* after the transparent plastic foil material has been applied to the cardboard blank. Indeed, the scoring taught by *Campbell et al.*, that necessarily must be done before the glue between the tapes and fiberboard material has dried, so as to enable shifting or movement of the two pieces, would seem to affect or diminish the precise alignment of the bend lines of the foil material with the fold lines of the cardboard as required by *Seufert*. Also, from the drawings such as shown in Fig. 12, it appears that when the blank of *Seufert* is folded, the foil material 3 will tend to bend inwardly and away from the cardboard as shown in

Fig. 12 to compensate for stresses applied thereto by bending rather than acting to reinforce the blank as required by *Campbell et al.*

Accordingly, combining all the teachings of *Seufert* with the method of *Campbell et al.*, would require that critical or expressly required steps of *Campbell et al.* be omitted in order to either apply a transparent plastic foil window taught by *Seufert* along an edge or about a cut-out portion of a cardboard blank, and then scoring it, contrary to the teachings of *Seufert*, or require the thinned down plastic material be applied over already scored fold lines, which is contrary to *Campbell, et al.* As such, the proposed modification would render these references unsatisfactory for their intended purposes and thus is not a proper combination. (See MPEP § 2143.02). Still further, *Campbell et al.* also teaches that cut-out portions 10 are stamped or formed in the cardboard blank, which would also appear to reduce or affect the strength of the plastic foil material of *Seufert*, which has already been thinned down to approximately 40-60 μm .

In response to Applicant's previous arguments, the Examiner has asserted that Applicant has attempted to attack the references individually to show non-obviousness. However, Applicant respectfully points out that it has not attempted to attack the cited references individually, but in order to fully respond to the rejection of obviousness based upon the cited combination of the references, it is necessary for Applicant to discuss the teachings provided by these references and specifically point out issues with respect to the interpretation(s) of these references recited in the rejection, as well as the teachings of these references that teach away from each other and evidence/indicate that there is no suggestion or motivation to try to combine the teachings of these references to try to form the claimed invention. For example, contrary to the assertion made in the Official Action that "*Seufert* discloses more than merely producing receptacles with windows," it is respectfully pointed out that, as shown in the drawing figures,

Seufert does not disclose anything more than a windowed display box in which a stiff, transparent thermoplastic foil approximately 40-60 μm thick at its thinned down regions is used to either form a window over a cut-out section of cardboard of the folding box or is folded so as to form a side and/or corner of the folding box for display purposes.

In addition, contrary to the rejection, *Seufert* does not appear to disclose this transparent plastic foil as being a reinforcing material or performing such a reinforcing function as performed by the tapes shown in *Campbell et al.*, so as to be able to be substituted therefore. Indeed, given the thicknesses of the foil of between 40-60 μm at its thinned down regions, it is respectfully submitted that such material clearly is not designed to be a reinforcing material as taught by the claimed invention or as envisioned by *Campbell et al.* Still further, the reference to column 6, lines 37-42, in the Official Action does not support an interpretation of *Seufert* as disclosing other types of boxes, much less that the plastic foil that is thinned down before its application to a cardboard blank at a cut-out section or along one edge thereof performs any reinforcing function. In fact, this passage limits any application to other "foldable packaging units, as for instance foldable slip-on covers...to the extent that the overlap between the cardboard and plastic foil occurs in the area of box edges." (See col. 6, ll. 39 – 42(emphasis added)). Accordingly, the disclosure of *Seufert* does not teach or suggest a method of making a reinforced paperboard container with a reinforcing material as asserted by the Official Action, but rather is specifically directed to display type boxes. It therefore is submitted that there is no suggestion to combine or form the folding box with transparent plastic material of *Seufert* with the method of *Campbell et al.* to form a reinforced fiberboard blank.

Accordingly, it is respectfully submitted that there is no suggestion or motivation to combine the teachings of *Campbell et al.* and *Seufert* when considered as a whole for all that they

teach. Even if such a combination were made, it would still not be successful at trying to form the claimed invention as the two references teach vastly different types of products that are assembled in divergent manners or methods such that these references appear to teach away from one another. Applicant, therefore, respectfully requests that this rejection be reconsidered and withdrawn and that claims 1-5, 7, 11 and 33-37 as now pending are patentable over the cited combination of references.

Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Campbell et al.* in view of *Seufert* '916 as applied to claims 1-5, 7, 11 and 33-37, and in further view of *Seufert* '206. Applicant respectfully submits that claim 6, which depends from claim 5, likewise is allowable over the cited art of record for the reasons discussed above with reference to Claims 1-5. Accordingly, it is respectfully requested that this rejection be withdrawn and that claim 6 is patentable under 35 U.S.C. § 103(a) over the cited art of record.

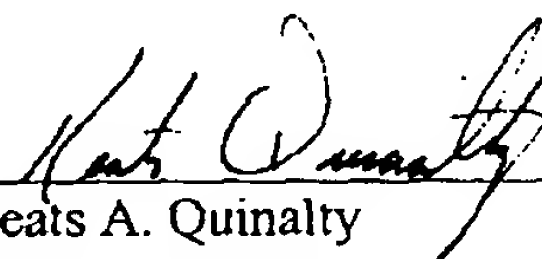
Claims 8-10 and 12-15 additionally have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Campbell et al.* in view of *Seufert* as applied to claims 1-5, 7, 11 and 33-37 and in further view of *Haddock*. As discussed above with reference with claims 1-5, 7, 11 and 33-37, it is submitted that there is no suggestion or motivation, nor has any such suggestion or motivation been shown to support the combination of the teachings of *Campbell et al.* in view of *Seufert*. It is therefore submitted that claims 8-10 and 12-15 are not made obvious by and thus are patentable over the cited combination of references, and it is respectfully submitted that this rejection be withdrawn.

In summary, Applicant respectfully submits that claims 1-15 and 33-37, currently pending in the present application, define a method of making a reinforced carton blank that is not taught or suggested by the cited art of references either alone or in combination. Reconsideration of the

foregoing final rejection is therefore respectfully requested, and an early notice of allowance accordingly is solicited. Should the Examiner have any further questions regarding this response, he is invited and urged to telephone the undersigned attorney.

Respectfully submitted,

7/10/03
Date


Keats A. Quinalty
Reg. No. 46,426
D. Scott Sudderth
Reg. No. 34,026

WOMBLE CARLYLE SANDRIDGE
& RICE, PLLC
P.O. Box 7037
Atlanta, Georgia 30357-0037
Telephone: (404) 879-2423
Facsimile: (404) 879-2923